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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,200	05/14/2001	Cindy L. Price	659-787	8178

7590

04/22/2004

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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 04/22/2004

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,200

Applicant(s)

PRICE ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-8-04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-11,14,16,17,20-22,24-27,30-32,34,35,40,41,44 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3, 6-7, 12-13, 15, 18 -19, 23, 28-29, 33, 36-39, 42-43 and 46 .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2-8-04 has been entered.

Election/Restrictions

2. Claims 3, 6-7, 12-13, 15, 18 -19, 23, 28-29, 33, 36-39, 42-43 and 46 are still withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

Specification

Drawings

3. The drawings were received on 2-8-04. These drawings are approved by the Examiner.

Claim Objections

4. Claims 9, 21 and 31 are objected to because of the following informalities: on line 2 of these claims, is there a word or words missing? Appropriate correction is required.

Claim Language Interpretation

5. In claims 1, 14 and 24, with respect to the side margin being unattached to the bodyside surface of the body panel between the free edge and the location, "unattached" is interpreted as not being directly attached.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2, 4-5, 8-11, 14, 16-17, 20-22, 24-27, 30-32, 34-35, 40-41 and 44-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Glaug '233.

See Figures 3 and 5, col. 12, lines 4-20, col. 11, lines 33-38 and 55-67, i.e. body panels are 22 and 24, absorbent composite is 50 which includes a backsheet 48, a topsheet 46, a retention portion 50, the composite is connected to the body surface of the panels at longitudinally extending locations 44 and side margins 26C and 26D are formed between free

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edges and the locations 44 and include both the topsheet and backsheet extending outward of the side edges of the retention portion and an elastic element which extends less than the entire length of the composite, i.e. between 5% and 100% as shown in the Figures. The side margins between the free edges and the locations 44 are directly unattached to the panel. With regard to the method claims, see col. 1, lines 10-15, col. 4, lines 58-61, col. 5, lines 41-50.

8. Claims 1, 4-5, 8-11, and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Kao '131.

See Figures 1-4, paragraph bridging pages 5-6 and page 7, line 25-page 9, line 17, i.e. body panel is 2, absorbent composite is 3 which includes a backsheet 16, a topsheet 15, a retention portion 17, the composite is connected to the body surface of the panels at longitudinally extending locations A and side margins 18 are formed between free edges and the locations A and include both the topsheet and backsheet extending outward of the side edges of the retention portion and an elastic element which extends less than the entire length of the composite, i.e. between 5% and 100% as shown in the Figures. The side margins between the free edges and the locations A are directly unattached to the panel. With regard to the method claims, see page 10, lines 9-23.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 2, 14, 16-17, 20-22, 24-27, 30-32, 40-41 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao '131 in view of Rajala '922.

See rejection supra, page 4, lines 5-7 and page 9, lines 6-16, i.e. the Kao '131 device includes a panel of inner and outer layers and the panel includes monolithically formed front and rear sections while Applicant claims the front and rear sections being first and second panels with terminal crotch edges that are spaced apart. It is noted that the claims do not require the garment having no crotch section or a crotch section formed only of the absorbent composite. However see Rajala '922, col. 6, line 36, col. 2, lines 60-66 and abstract, lines 1-5, i.e. interchangeability of monolithically formed front and rear sections of an inner layer and an inner layer formed of two panels with terminal crotch edges which are longitudinally spaced. To make the inner liner of Kao two spaced panels rather than one panel would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Rajala. In so doing, the modified Kao device would include the claimed body panel structure.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-2, 4-5, 8-11, 14, 16-17, 20-22, 24-27, 30-32, 34-35, 40-41 and 44-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of allowed copending U.S. Patent Application No. 10/053,251. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed prior to '251 but there was no administrative delay, the one way In re Vogel test applies, i.e. are the claims in the instant application obvious in view of the claims of the '251 application. The answer is yes. The claims of the instant application are broader than the '251 claims. Once the Applicant has received a patent for a species or more specific embodiment Applicant is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Common Ownership

13. Claims 1-2, 4-5, 8-11, 14, 16-17, 20-22, 24-27, 30-32, 34-35, 40-41 and 44-45 are directed to an invention not patentably distinct from the allowed claims of commonly assigned 10/053,251. Specifically, see the double patenting rejection above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 10/053,251, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the

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invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

14. Applicants remarks have been considered but are either deemed moot in that they have not been reraised or are deemed not persuasive for the reasons set forth supra.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617.

The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 308-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
April 16, 2004